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Section II: REMARKS

It is respectfully requested that the changes as noted above in Section I be made to the present application.

In the above referenced Office Action, which was mailed on 11/15/2004, Prosecution of the present application was reopened in view of applicant's Appeal Brief filed on 7/26/2004. In the Office Action, claims 1-5, 7-15 and 17-25 were rejected under 35 USC 102(e) as being anticipated by the Williams reference (US 2002/0032612 A1, hereinafter referred to as "Williams"), and claims 6 and 16 were rejected under 35 USC 103(a) as being unpatentable over Williams in view of the Siegel reference (US 2001/0032147 A1, hereinafter referred to as "Siegel"). The above noted rejections are respectfully traversed. However, in order to further the prosecution of the present application, and without waiving any of applicant's rights to argue the allowability of the originally presented claims in a subsequent appeal or other proceeding in the event that the Examiner does not concur that the present amendment places the application in condition for allowance, applicant has herein amended the claims to place them in condition for allowance.

It is noted that the present application includes claims 1-25 with claims 1, 11 and 21 being independent claims, and claims 2-10 being ultimately dependent from claim 1, claims 12-20 being ultimately dependent from claim 11 and claims 22-25 being dependent from claim 21. Independent claims 1, 11 and 21 (and therefore also claims 2-10, 12-20 and 22-25 through dependence) have herein been amended to even more clearly distinguish the present invention from the cited references and as herein amended, claims 1-25 are now believed to be in condition for

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allowance under 35 USC 102(e) and 35 USC 103(a) over Williams and/or Siegel, taken alone or in combination.

The present invention as currently recited in the amended claims includes several sequential steps in the processing of merchandise to be returned from a customer. As recited, for example, in amended claim 1, the process includes all of the following elements and relationships: receiving an order for an item from a customer, wherein the order includes customer-related information, storing the customer-related information in a storage device, sending the item to the customer by the selling merchant, receiving a return communication from the customer requesting a return of the item to the selling merchant, retrieving the customer-related information from the storage device, effecting an auction of said item by said selling merchant following the receiving of the return communication from the customer, and sending a shipping communication including portions of the customer-related information to the customer, with the shipping communication identifying a receiving entity to whom said item is to be returned, the receiving party being a winner of said auction. It is especially noted that it is the selling merchant who conducts the auction and **the address to which the merchandise is to be returned is not known or sent to the customer until an auction for the returned item has been completed and the winner of the auction is known.** It is only then that the receiving party is identified on a shipping communication or return label which is then sent to the customer to facilitate the return of the item to the auction winner. **This methodology improves the processing of returned items since it involves only two shipments, i.e. the initial shipment of the product to the customer and the return shipment of the product to the winner of an auction initiated by the seller.**

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It is submitted that the cited references do not anticipate or render obvious the present invention as herein set forth in the amended claims. Williams provides an apparatus, system and method for online, multi-parcel, multi-carrier multi-service parcel returns shipping management but does not teach, disclose or suggest the use of an auction. Siegel does not teach, disclose or suggest the use of an auction in determining the address to which the returned item is to be sent **by the customer**; and even the combination of Williams and Siegel does not disclose, teach or suggest the use of **an auction initiated by the seller in order to determine the address to which a customer is to send a returned item**. In the above referenced Office Action, on page 6, in rejecting claims 6 and 16, the Examiner states that "Williams does not expressly disclose a method including effecting an auction of said item following said receiving of said return communication from said customer, said receiving entity being a winner of said auction." The Examiner then cites Siegel as disclosing an auction for the disposing of returned items, stating that it would have been obvious to modify the system of Williams to include the teachings of Siegel. However, it is noted that Siegel teaches that items to be returned are sent to a **"local returns agent"** (Siegel, paragraph 0009 cited by the Examiner), and then the local returns agent may liquidate the item via an online auction. Thus using Siegel, an item is initially shipped from a seller to a customer, and then from a customer to a "local returns agent" and from there it is sent to a third party for ultimate disposition. **That process involves three shipments of the purchased item from initial shipment to ultimate disposition whereas, in contrast, by using an auction initiated by a seller prior to sending a customer a return shipping label, and by identifying the winner of the auction as the party to whom the return is to be sent from the customer, the present invention requires only two shipments instead of three as**

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required by the Williams-Siegel combination.

In view of the above-noted distinction, the independent claims 1, 11 and 21 have herein been amended to include, *inter alia*, the sequence of (1) customer return notice to seller, (2) auctioning and (3) sending of the shipping label to the customer identifying the winner of the auction as the return address. Further, claims 6 and 16 have herein been cancelled, without prejudice, with the substance of those claims being included in one or more of the remaining claims.

It should be noted that applicant is claiming only that the **total combination** of elements **and relationships** as recited in the claims as herein amended, is neither anticipated nor rendered obvious by the cited references. Applicant is aware the individual elements of any claim can be isolated, and, when standing alone, those elements can be found in existing references. The similarity of various pieces and parts of the references as noted on pages 2-7 of the above-identified Office Action have been noted but it is believed that there is no suggestion or nexus among the references to even suggest the total combination of elements and relationships as recited in the claims as herein amended.

In view of the above discussion and the amendments to the claims as herein noted, it is submitted that claims 1-5, 7-15 and 17-25 are allowable under 35 USC 102(e) over Williams and 35 USC 103(a) over the combination of Williams and Siegel.

Thus, it is submitted that claims 1-5, 7-15 and 17-25, as herein presented, are believed to be in condition for allowance, an early notice of which is hereby requested. If any outstanding issues remain, or if the Examiner has any further suggestions for

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expediting the allowance of this application, and especially if one or more new references are cited, the Examiner is invited to contact the undersigned at the telephone number indicated below, prior to the issuance of another Office Action, in order to allow the applicant the opportunity to further amend the claims by Supplemental Amendment or Examiner's Amendment, as may be appropriate, to place the claims in condition for allowance. The Examiner's attention to this matter is greatly appreciated.

Respectfully submitted,

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